

REMARKS

Applicant appreciates the continued thorough examination of the present application and the additional analysis provided by the Advisory Action. The present RCE is being filed to further amend the claims by incorporating recitations of Claims 15 and 16 into independent Claims 11 and 31, and by incorporating recitations of Claims 53 and 54 into independent Claim 49. Applicant respectfully submits that the claims are in condition for allowance for the reasons that will now be described.

In particular, in the following remarks, the allowability of independent Claims 11, 31 and 49 prior to the present Amendment will first be described. Then, the Advisory Action will be discussed. Finally, the present amendments to the claims and their additional grounds for patentability over the art of record will be described.

In view of the above, Applicant also hereby requests a telephone interview with the Examiner before another action on the merits, if the present Amendment does not place the application in condition for allowance.

Independent Claims 11, 31 and 49 Were Allowable Prior to the Present Amendment

Prior to the present Amendment, independent Claims 11, 31 and 49 stood rejected under 35 USC §103(a) over U.S. Patent 7,099,837 to Weibel et al. ("Weibel") in view of Applicant's Background of Invention, in further view of Official Notice, in further view of U.S. Patent 5,717,939 to Bricklin et al. ("Bricklin") and further in view of U.S. Patent 6,282,552 to Thompson et al. ("Thompson"). In Applicant's Request for Reconsideration of February 9, 2009, Applicant provided five (5) independent reasons why these claims were patentable under 35 USC §103:

- (1) the combination of Bricklin into Weibel would destroy the intended operability of Weibel;
- (2) Weibel teaches away from the use of an electronic spreadsheet for an invoice;
- (3) the rejection does not provide the requisite articulated reasoning with a rational underpinning to support the conclusion of unobviousness;
- (4) the independent existence of spreadsheets does not negate unobviousness; and
- (5) even if properly combined, the claim elements simply would not be met.

The detailed analysis that was provided at Pages 3-6 of the Request for Reconsideration of February 9, 2009 will not be reproduced herein for the sake of brevity, but are incorporated herein by reference. However, as noted, the combination of five separate references (1) would destroy the operability of the primary reference, and (2) the primary reference actually teaches away from the combination. Moreover, (3) the rejection does not provide the requisite articulated reasoning for the combination, but merely demonstrates (4) the independent existence of spreadsheets. Finally, (5) even if somehow combined, the combination would still not yield the claim recitations.

Each of these five (5) reasons provided an independent basis as to patentability of Claim 11 over Weibel in view of Applicant's Background of Invention, in further view of Official Notice, in further view of Bricklin and further in view of Thompson. The combination of (5) reasons provided compelling evidence. Accordingly, independent Claims 11, 31 and 49 were patentable even prior to the present Amendment.

The Advisory Action Did Not Change the Above Analysis

The Advisory Action of March 19, 2009 reiterated Applicant's analysis, but stated:

...The Examiner disagrees. The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). The examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). Weibel, Bricklin and Thompson are all directed toward invoice system. Weibel ('837) fails to explicitly disclose the customer electronic invoice is generated by adding an additional data field to the data fields in the electronic spreadsheet and/or by altering a data field in the electronic spreadsheet. Bricklin ('939) teaches an electronic invoice comprising an electronic spreadsheet having modifiable data fields therein, see Fig 3 of Bricklin. Thompson ('552) teaches generating invoice (see figure 2 (210)) and changing electronic invoice by modifying/altering

fields, see at least Abstract of Thompson. Therefore, the Examiner asserts that it would have been obvious for one of ordinary skill in the art at the time the invention was made to modify Weibel's invention to include the customer electronic invoice is generated by adding an additional data field to the data fields in the electronic spreadsheet and/or by altering a data field in the electronic spreadsheet. One would be motivated to do so for the benefit of modifying invoice data more easily. Since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable. Therefore, Applicant's arguments [sic] are not persuasive. (Emphasis added.)

In response, Applicant respectfully submits that even though Weibel, Bricklin and Thompson are all directed toward invoice systems, Applicants have already shown that the combination of Bricklin into Weibel would destroy the intended operability of Weibel. In particular, as was already shown, Weibel's invoice is an electronic document that is used to store a replica of an invoice in a well known digital document format, such as .tif, .jpeg, .pdf or the like. The incorporation of a spreadsheet would destroy the intended operability of Weibel as a digital document. Applicant respectfully submits that in attempting to combine Bricklin into Weibel, one must take into account that this combination would destroy the operability of the primary reference, even though both references are directed to invoice systems. In fact, by describing in detail the linking of a detailed advertisement image document and a separate invoice digital document, Weibel actually teaches away from the use of an electronic spreadsheet for an invoice. As already noted, the Supreme Court has held that references cannot be combined while ignoring the clear teaching away of one of the references.

Moreover, although Thompson also teaches generating an invoice, Thompson does not deal with spreadsheets but, rather, deals with HTML that is used to create controls including check box selections, radio buttons, drop-down selection lists, etc. Accordingly, the modification taught in Thompson of adding additional categories and category boxes would not describe or suggest the claimed adding of an additional data field to the data field in an electronic spreadsheet and/or altering a data field in the electronic spreadsheet, as recited in the independent claims.

Finally, Applicant agrees that the claimed invention is a combination of old elements. However, a large number of old elements are combined in the independent claims in a unique way to provide unique advantages in the field of business directory advertisement billing, in which tear pages have been used for many years in billing between a business directory publisher, third party advertisement sellers referred to as Customer Marketing Representatives (CMRs) and the customers of the CMR.

Accordingly, even before the present Amendment, the independent claims were patentable over the combination of five references, notwithstanding the Examiner's above quoted analysis in the Advisory Action.

The Amended Claims Provide Additional Bases For Patentability

As noted above, independent Claim 11 has been amended by incorporating therein recitations of Claims 15 and 16. Thus, Claim 11 now also recites:

sending an electronic CMR credit/debit form to the business directory publisher that indicates that an error was made in the CMR electronic invoice for the business directory advertisement that was sold by the CMR to the CMR customer for the business directory publisher, in response to detecting the error that was made in the electronic invoice for the business directory advertisement that was sold by the CMR to the CMR customer for the business directory publisher; and

sending an electronic CMR adjustment form to the business directory publisher that indicates that an error was made in the business directory advertisement that was sold by the CMR to the CMR customer for the business directory publisher, in response to detecting the error that was made in the business directory advertisement that was sold by the CMR to the CMR customer for the business directory publisher.

Similar recitations have been added to remaining independent Claims 31 and 49, which are system and computer program analogs of Claim 11. Only Claim 11 will be analyzed below in the interest of brevity

In the Official Action of December 11, 2008, Claim 15 stood rejected under the combination of five (5) references described above, and in further view of U.S. Patent Application Publication No. 2002/0010664 to Rabideau et al. ("Rabideau"). However, Rabideau relates to a *"Method and System for Conducting a Target Audit In a High Volume Transaction Environment"*, as noted by the Rabideau title. In fact, Paragraph [0005] of Rabideau, that was

cited in rejecting Claim 15, relates to auditing processes that are conducted in the airline industry, including unique repricing rules that relate to the airline industry. Thus, it would not be predictable to add Rabideau's auditing process for the airline industry into a business directory advertisement billing method, as recited in Claim 11.

Moreover, even if somehow combinable, Rabideau simply does not describe or suggest:

sending an electronic CMR credit/debit form to the business directory publisher that indicates that an error was made in the CMR electronic invoice for the business directory advertisement that was sold by the CMR to the CMR customer for the business directory publisher, in response to detecting the error that was made in the electronic invoice for the business directory advertisement that was sold by the CMR to the CMR customer for the business directory publisher,

as recited in amended Claim 11. Accordingly, independent Claims 11, 31 and 49 are patentable for at least these additional reasons.

Moreover, in the Official Action of December 11, 2008, Claim 16 was also rejected in further view of U.S. Patent 6,883,000 to Gropper. However, Gropper relates to a "*Business Card and Contact Management System*", as noted in the Gropper title. Moreover, Column 36, lines 32-34, and Column 32, lines 40-44 of Gropper that were cited in rejecting Claim 16 state:

...News and ads **208.2.10** can be textual, graphical (still or animated), video, audio or other digital format or a combination of any of the above....

...Concurrent to establishing a communication session with the client computer **100**, the supplemental client computer **115** automatically displays news and advertising information (FIG. 12) and status information to the user on the output device of the supplemental client computer **115**....

Even if it was somehow predictable to combine Gropper's business card and contact management into a business directory advertisement billing method, the following recitations of Claim 11 would simply not be described or suggested by the above quoted passages of Gropper:

sending an electronic CMR adjustment form to the business directory publisher that indicates that an error was made in the business directory advertisement that was sold by the CMR to the CMR customer for the business directory publisher, in response to detecting the error that was made in the business directory advertisement that was sold by the CMR to the CMR customer for the business directory publisher

Accordingly, Claims 11, 31 and 49 are independently patentable for at least these additional reasons.

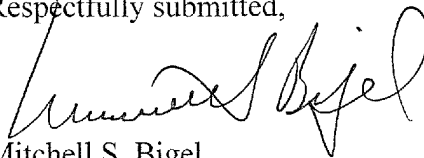
Request for Telephone Interview

Applicant has now extensively amended the independent claims, even though Applicant has presented five cogent reasons why the claims were already patentable, and these reasons have not been rebutted. If the present Amendment does not place the application in condition for allowance, Applicant respectfully requests a telephone interview with the Examiner to discuss why the present amendments do not place the application in condition for allowance, prior to issuing another Official Action.

Conclusion

The independent claims already were patentable over the combination of five (5) references. However, in a sincere effort to advance the application to allowance, the present RCE is being filed and many additional recitations have been added to all of the independent claims. These claims are clearly patentable over the seven (7) cited references, for the reasons that were described above. Accordingly, Applicant respectfully requests allowance of the present application. Alternatively, if allowance is not forthcoming, Applicant respectfully requests the Examiner to contact the undersigned by telephone at (919) 854-1400 to set up a telephone interview.

Respectfully submitted,



Mitchell S. Bigel
Registration No. 29,614
Attorney for Applicant

Customer Number 39072

AT&T Legal Department
ATTN: Patent Docketing
Room 2A-207
One AT&T Way
Bedminster, NJ 07921